

persons; charging that periodic amount in an insurance program over a period of time; and administering the insurance program, wherein the two or more natural persons are a cohabiting same sex couple.

Specific basis for this aspect of the invention can be found in paragraph [0009] of the as-filed application. The only modification made to the claim in the last amendment was to more specifically define the people involved in the contractual relationship.

In re Marzocchi, 439 F.2d 220, 169 USPQ 367 (CCPA 1971) places specific obligations on a patent examiner whenever a claim is rejected for lack of enablement. *Marzocchi* quite clearly states:

“a specification disclosure which contains a teaching of the manner and process of using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of § 112 unless there is reason to doubt the objective truth of the statements contained therein”

The decision goes on:

“It is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.”

To reject a disclosure for lack of enablement, however, the Examiner must provide evidence or technical reasoning. This has not been done in the rejection.

Further, without a reason to doubt the truth of the statements made in the application, the application must be considered enabling. *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993); *In re Marzocchi*, *supra*.

The rejection should be withdrawn.

B. 35 U.S.C. § 103 – Claim 9:

Claim 9 stands rejected under 35 U.S.C. § 103 as allegedly being rendered obvious by Golden in view of “official notice” (without citing a prior art reference). Applicants traverse the rejection.

First, the Office makes this obviousness rejection without even identifying what the level of ordinary skill is, which is improper on its face.

Second, the Manual of Patent Examining Procedure, § 2144.03 admittedly permits patent examiners to take official notice under certain circumstances. However, these circumstances are very limited, and would appear to be improper as attempted to be applied in this case. As provided for by MPEP 2144.033:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[W]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). While the court explained that, "as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction," it made clear that such "expertise may provide sufficient support for conclusions [only] as to peripheral issues." *Id.* at 1385-86, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002) (In reversing the Board's decision, the court stated "'common knowledge and common sense' on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation....The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.").

Clearly, this obviousness rejection is not well-based, and should be withdrawn.

C. 35 U.S.C. 103 – Other claims:

Claims 1-8 and 10-20 stand rejected under 35 U.S.C. § 103 as allegedly being made obvious by Golden in view of Roberts. Applicants traverse the rejection.

Claim 12 recites a method of doing business comprising determining a periodic amount to be charged a prospective participant for insurance covering at least some financial consequences in addition to legal fees of the untimely ending of a contractual relationship between two or more natural persons; charging that periodic amount in an insurance program over a period of time; and administering the insurance program, wherein the financial consequences comprise, in addition to legal fees, financial consequences selected from the group consisting of moving costs, a child's education, a former partner's education, health insurance premiums, life insurance premiums, and combinations of any thereof.

Golden was acknowledged as not teaching wherein the "financial consequences comprise, in addition to legal fees, financial consequences selected from the group consisting of moving costs, a child's education, a former partner's education, health insurance premiums, life insurance premiums, and combinations of any thereof".

Roberts was thought to provide the missing elements. Roberts, in its abstract, discloses

"A method and apparatus are provided to insure a means of purchasing a floating rate zero coupon note that is designed to fund a certain future liability of uncertain value and thereby defease fully its future cost. The method is a one-year renewable term insurance program that fully funds the purchase of a certain floating rate zero coupon note upon the occurrence of some catastrophic event, such as the death of the insured. The system projects the expected death benefit payment and then calculates the annual insurance premium based on the expected death benefit payment, type of policy, and personal and risk characteristics of the insured." (Underlining added).

Roberts continues:

"The floating rate zero coupon note is designed to fund a future liability whose projected due date and whose present cost are known and whose future cost is unknown but can be projected with some risk factor." (Roberts, col. 2, lines 8-11).

And,

In view of the foregoing, it is an object of [Roberts] to provide a data processing method and apparatus for implementing a life insurance program which provides the beneficiary a benefit sufficient to cover fully the uncertain future cost of a floating rate zero coupon note, which is designed to fund an uncertain future liability whose cost can be projected on the basis of current cost data and assumptions regarding the rate of change of that data, and which automatically determines the insurance premiums that must be charged in order properly to fund the insurance program.

It is a more particular object of [Roberts] to provide data processing methods and apparatus for implementing a life insurance program which provides a parent or relative who wishes to purchase floating rate zero coupon notes designed to defease the uncertain future cost of a college education for a child with assurance that the child's education will be fully funded in the event the parent or relative should die before he or she can fully purchase the full complement of floating rate zero coupon notes needed to defease the cost of the child's college education. (Roberts, col. 2, line 63 to col. 3, lines 15).

Applicants respectfully disagree with the obviousness rejection.

First, the Office makes this obviousness rejection without even identifying what the level of ordinary skill is, which is improper on its face.

Second, there must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007). That reason is not apparent in the instant case absent the inappropriate application of hindsight.

There would be no reason to combine Roberts' "one-year renewable term insurance program" used to fund an uncertain cost of a college education with Golden. Roberts' goals, while laudable, "teach away" from the instantly claimed methods, which are meant to enhance the financial security of a family, not hedge against an uncertain college tuition inflation (particularly in the event of death of a parent). *In re Peterson*, 315 F.3d 1325, 1331 (Fed. Cir. 2003).

The Office's reliance on Golden's paragraph 10 does not rectify the situation. Golden merely addresses "child support payments", which are a far cry from college tuition, let alone the uncertain price of future college tuition.

In view of the foregoing, applicants request that the rejection be withdrawn.

Claims 4, 11, 14, 15, and 17 stand rejected under 35 U.S.C. § 103 as allegedly being made obvious by Golden and U.S. Patent Application Publication No. 2005/038681 to Covert, further in view of Roberts. Applicants traverse the rejection.

First, the Office makes this obviousness rejection without even identifying what the level of ordinary skill is, which is improper on its face.

Second, Covert is directed to “Family Protector Insurance”, which insures the payor spouse’s obligations (*e.g.*, by insuring the payor spouse’s health or life against disability and death, respectively) after a decision to divorce has already been made. (*See, e.g.*, paragraphs [0033], [0034], [0036], [0061], [0062], [0064], [0066], [0068], and [0071] and claims 3-5 of Covert). As stated in paragraph [0033] of Covert, the problem Covert seeks to solve is that “there are no insurance products currently offered that in any way protect the payee spouse in the event that the alimony paying spouse is disabled and unable to work, in the event the payor spouse dies, or in the event the payor spouse ceases making payments or makes reduced payments.” Covert goes so far in some cases as to even presume a court order requiring Family Protector Insurance has already been issued. (*See, e.g.*, paragraphs [0036], [0061], [0062], [0064], [0066], [0068], and [0071] and claims 3-5 of Covert).

While being potentially useful to the payee spouse, Covert’s Family Protector Insurance is different than applicants’ claimed method, which can be beneficial to everyone involved. Specifically, applicants’ claims are directed to a method much more akin to long term health or life insurance wherein payments are made, but no desire is harbored by the participants to ever have the insured event actually occur (*e.g.*, divorce in the case of a married couple is much like sickness or death, respectively, in the cases of health and life insurance; they are insured against, but no one wants them to occur). (*See, e.g.*, paragraph [0008] of applicants’ published application). Unlike Covert, under applicants’ claim 12, the policy is contracted and entered into (and premiums have been paid) long before an end (*e.g.*, a divorce) is even contemplated by the contracting persons (*e.g.*, as was claimed in claim 1, applicants’ insurance policy insured against the untimely end of a contractual relationship, it was not intended to solely protect one party’s interests as the results of an already made decision to end the contractual relationship).

For example, as described in paragraph [0014] of applicants’ published application, installments for applicants’ invention “can start at the day of marriage or before or during a

marriage (or another such contract).”

Applicants’ claim 12 (from which the rejected claims depend) is in stark contrast to Covert, where, in paragraph [0061], Covert states “Moreover, it should also be apparent that this transaction could be initiated at the time the divorce is finalized, at the time any child support payments are ordered, or at any time subsequent.”

As further described in paragraph [0024] of applicants’ published application,

“The policy could be sold to prospective participants in the usual ways for selling life insurance. For example, insurance salesmen could offer it to new couples.”

Selling an insurance policy for the untimely ending of a relationship to newlyweds or their parents, guardians or via their employers is not the same as selling Covert’s Family Protector Insurance to a divorcing couple, where the damage has already been done.

This fundamental difference between applicants’ invention and Covert explains why the elements of claims 6 (refunding premiums if the contractual relationship does not occur), 7 (determining the amount of coverage dependent on investment return of the premium amounts), 13 (basing the premiums on the basis of the participants’ ages), and 19 (investing the premiums paid) could not be found by the Office in Covert. Such elements are irrelevant to Covert’s Family Protector Insurance, where there is a short investment time frame and the time value of money cannot be as readily utilized.

Specifically, independent claim 12 (from which all of the rejected claims depend) recites that “the charges for the periodic payment start either at or before the beginning of the contractual relationship between the two or more natural persons” wherein the “financial consequences comprise, in addition to legal fees, financial consequences selected from the group consisting of moving costs, a child’s education, a former partner’s education, health insurance premiums, life insurance premiums, and combinations of any thereof.

Roberts does not rectify the situation, and the rejection should be withdrawn for that reason.

Furthermore, with respect to claim 11, applicants reviewed paragraph [0036] of Covert, and were unable to find a third party (not the payor or payee spouse) taking out the insurance policy, such as in laws or an employer, which is an element of the claim.

With respect to claim 14, applicants reviewed paragraph [0036] of Covert, and were unable to find basing the periodic amount to be charged, in part, on the prospective participant's projected earnings, which is an element of the claim.

With respect to claim 15, applicants reviewed paragraph [0036] of Covert, and were unable to find basing the periodic amount to be charged, in part, on the prospective participant's partner's projected earnings, which is an element of the claim.

In view of the foregoing, applicants request that the rejection be withdrawn.

Claims 6, 7, and 19 stand rejected under 35 U.S.C. § 103 as allegedly being made obvious by Golden, Covert, Roberts, and Mooney. Applicants traverse the rejection.

First, the Office makes this obviousness rejection without even identifying what the level of ordinary skill is, which is improper on its face.

Second, and as previously discussed, Roberts does not rectify the lack of a reason to combine in the manner claimed (absent impermissible hindsight), and the rejection should be withdrawn for that reason. Accordingly, the rejection should be withdrawn.

Claim 13 stands rejected under 35 U.S.C. § 103 as allegedly being made obvious by Golden, Roberts, and Flagg. Applicants traverse the rejection.

First, the Office makes this obviousness rejection without even identifying what the level of ordinary skill is, which is improper on its face.

Second, and as previously discussed, Roberts does not rectify the lack of a reason to combine in the manner claimed (absent impermissible hindsight), and the rejection should be withdrawn for that reason.

Furthermore, absent hindsight and only after being appraised of applicants' disclosure, would one of ordinary skill in the art even consider combining Covert, Roberts, and Flagg in the manner set forth in the Office action. There is just no motivation to combine the references as suggested.

The application should be in condition for allowance. If, however, questions remain after consideration of the foregoing, the Office is kindly requested to contact applicants' attorney at

the address or telephone number given herein.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Allen C. Turner', with a stylized, flowing script.

Allen C. Turner

Registration No. 33,041

Attorney for Applicants

TRASKBRITT, P.C.

P.O. Box 2550

Salt Lake City, Utah 84110-2550

Telephone: 801-532-1922

Date: November 5, 2007